

REMARKS

This responds to the Office Action mailed on March 22, 2007.

Claim 16 is amended, no claims are canceled, and no claims are added; as a result, claims 16- 39 are now pending in this application. Applicant respectfully submits that the amendment of claim 1, supported by the instant application at Figure 5 is a minor amendment introduced for further clarification.

§103 Rejection of the Claims

Claims 16-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Padgett et al. (U.S. 6,167,518, hereinafter “Padgett”) in view of Ross (U.S. 6,195,447), and further in view of Beetcher et al. (U.S. 5,933,497, hereinafter “Beetcher”), and further in view of Cane et al. (U.S. 5,416,840, hereinafter “Cane”).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for the following reasons:

Even if combined, the cited references fail to teach or suggest all of the elements of Applicant’s claimed invention;

The reference (or references when combined) must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 16 recites, “receiving at least one response from the user computer, the at least one response including a first fingerprint file and a first identification for the user, said first fingerprint file including at least one identifying characteristic of the user computer.” The Office Action at page 3 Concedes, “ Padgett et al (‘518) does not explicitly disclose the feature of . . . receiving at least one response from the user computer, the at least one response including a first fingerprint file and a first identification for the user.” However, the Office Action asserts that Ross (Col. 3, lines 56-59) discloses these claim feature. *Id* The cited passage was analyzed in a previous response (response mailed 4/13/2005, page 8). In that passage, what is received is a

scanned fingerprint image data and not *a first fingerprint file . . . said first fingerprint file including at least one identifying characteristic of the user computer*, as recited in claim 16. Moreover, Applicant cannot find any other passage in Ross that teaches this claim feature. As such, Ross does not teach or suggest the limitation of, “*receiving at least one response . . . one response including a first fingerprint file . . . said first fingerprint file including at least one identifying characteristic of the user computer*,” as recited in claim 16.

Claim 16 further recites:

comparing the first fingerprint file against a second fingerprint file, to verify the user computer, the second fingerprint file accessible by the verification computer, said second fingerprint file including at least one identifying characteristic of a user computer;

The Office Action at page 3 asserts that Ross discloses this claim feature at column 4, lines 1-7. As argued in a previous response (mailed 4/13/2005, pages 8 and 9), the passage only describes processing a fingerprint image to gain access to a secure area. However, the fingerprint image in Ross is not the same as the *first fingerprint file* and is not compared with *a second fingerprint file to verify the user computer*. Thus, the passage does not teach “*comparing the first fingerprint file against a second fingerprint file, to verify the user computer. . . said second fingerprint file including at least one identifying characteristic of a user computer*,” as recited in claim 16.

Claim 16 also includes:

sending at least one verification response to the computer, based upon the comparing of the first fingerprint file against the second fingerprint file and upon the comparing of the first identification for the user against the second identification for the user;

The Office Action at page 3 alleges that Ross discloses this claim feature at column 4, lines 25-27. The passage states “The comparator generates a verification signal for transmission . . . to the access mechanism to admit or deny entry to the secured area.” However, assuming the Examiner has equated the “local site” in Ross with the “verification computer” in claim 1, clearly, the “scanner “in Ross should equate “the

computer” in claim 1, simply because it is the scanner that sends the request for verification to the local site (Ross, Figure 3). Consequently, the access mechanism is not the same as “the computer” in claim 1. Thus, the verification signal in Ross is not sent to the computer. Moreover, the verification signal in Ross is the result of comparing two finger print images which could only be used to identify a person and not *a user computer*. As such, the verification in Ross is not *based upon comparing the first fingerprint file against the second fingerprint file*. In sum, Ross does not teach or suggest, “*sending a verification response to the computer based upon the comparing of the first fingerprint file against the second fingerprint file . . .*,” as recited in claim 16.

With respect to Cane, the Office Action at page 2 states that Cane reference is cited as identifying the user computer. Applicant respectfully submits that the Examiner did not consider the claimed invention as a whole and only focused on the claim preamble. In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02.

In order for Cane to cure the deficiency of Padgett and Ross, it needs to be established that Cane teaches all claim features argued above with respect to the identification of user computer. Clearly, it is not sufficient for Cane to teach only the user computer identification, it must disclose the user computer identification through the same method steps as recited in claim 16.

Cane is directed to a method and system for protecting computer program distribution within a broadcast medium involving encrypting a portion of the computer program S_i using an encryption scheme keyed to both an encryption key SK_i and a program identifier i . (Abstract) Cane specifically discloses:

The method involves encrypting at least a portion of the computer program S_i using an encryption scheme keyed to both an encryption key

SK_i and a program identifier i. . . . Two tables are generated and stored in a memory device: a first table, including correlations between the encryption key SK_i and the program identifier i; and a second table, including correlations between a password key PK_j and the hardware identifier j. . . . The user-transmitted program identifier i is used to access the software encryption key SK_i from the first table, and the user-transmitted hardware identifier j is used to access the password key PK_j from the second table. A password P_{ij} is generated based on both the encryption key SK_i and the password key PK_j. The password P_{ij} is transmitted to the user for subsequent use in decrypting the selected software program S_i contained on the medium.
(Col.2, lines 20-55)

In the above passage, the user transmits a program identifier i and a hardware identifier j. Cane then uses the identifiers i and j, respectively, to access a software encryption key and a password key stored in a first and a second tables and, based on the accessed keys, generates a password and sends the password to the user. However, the passage is silent on *a second fingerprint file including at least one identifying characteristic of a user computer*. In addition, using a hardware identifier j to access a password key from a table is not the same as *comparing the first fingerprint file against a second fingerprint file, to verify the user computer*, as required by claim 16. Thus, cane in the quoted passage does not teach “comparing the first fingerprint file against a second fingerprint file, to verify the user computer. . . said second fingerprint file including at least one identifying characteristic of a user computer,” as recited in claim 16.

Moreover, sending a password, created based on the accessed keys, to the user by Cane, is not the same as the claimed feature of *sending at least one verification response to the computer*. Because, first of all, the user in Cane does not send a verification request to a verification computer; thus, is not the same as “*the computer*” in claim 16, which is the computer from which the request for verification was received by the verification computer. Secondly, the password sent to the user is not the same as *a verification based upon the comparing of the first fingerprint file against the second fingerprint file*, as required by claim 16. As such, Cane does not teach or suggest the feature of, “*sending at least one verification response to the computer, based upon the comparing of the first fingerprint file against the second fingerprint file and upon the*

comparing of the first identification for the user against the second identification for the user,” as recited in claim 16.

The Office Action at page 4 alleges that Beetcher discloses the claimed invention except for a second fingerprint file. The Office Action does not point to any passage in Beetcher that disclose the claim features discussed above. Beetcher is directed at distributing a software without entitlement to run and separately distributing encrypted entitlement key to enable the execution of the software.

In order for the combination of Padgett, Ross, Cane, and Beetcher to teach each and every element of claim 16, Beetcher should teach what is lacking in Padgett, Ross, and Cane. However, Applicant could not find any passage in Beetcher that teaches or suggests the claim features discussed above.

Consequently, at least for the reasons set forth above, Padgett, Ross, Cane, and Beetcher, individually or in the combination fail to teach or suggest each and every element of claim 16. As such, Applicant respectfully submit that independent claim 16 and its dependent claims 17-33 are allowable and it is requested the claim rejections under 35 U.S.C. § 103(a) be withdrawn.

Claim 34 recites, “a processor for communicating with the storage unit and the memory unit to compare information indicative of the second fingerprint file and the second identification for the user with information indicative of the first fingerprint file and the first identification file for the user.” The Office Action asserts Padgett teaches these claim features in the passages at column 2, lines 61-67 and column 3 lines 1-6. Padgett's passage at column 2, line 61 to column 3, line 6 states:

The digital representation of the registrant's biological indicia is encrypted using the registrant's private key and sent to the certificate authority along with the registrant's public key. The certificate authority decrypts the digital representation and stores it. The registrant then visits a remote registration terminal in person with the digital representation and other identifying documents. The operator of the remote registration terminal verifies the identity of the registrant from the identifying documents and transmits the digitized representation to the certificate authority. The certificate authority compares the decrypted digital representation with the representation sent from the remote registration terminal.

This passage describes comparing two items. The certificate authority compares decrypted biological information with information sent from a remote terminal. However, claim 34's processor compares four items. In particular, claim 34's processor is to compare information indicative of *the second fingerprint file and the second identification for the user* with information indicative of *the first fingerprint file and the first identification for the user*. Therefore, this passage does not teach or suggest the processor of claim 34. Applicant cannot find any other passages in Ross that teaches this claim feature.

Claim 34 recites, “a storage unit to receive information indicative of a first fingerprint file and a first identification for the user, said first fingerprint file including at least one identifying characteristic of the user computer.” Claim 34 also recites, “a memory unit to receive information indicative of a first fingerprint file and a first identification for the user, said first fingerprint file including at least one identifying characteristic of the user computer.” The Office Action asserts that Ross discloses these claim features at column 3, line 56-59. The passage in Ross states:

At the local site 40, a processor 42 receives the scanned fingerprint image data from the scanner 32 across the transmission line 26 and acts to locate the real time discrete topographical minutia points.
(Col. 3, lines 56-59)

This passage clearly does not teach or suggest the claimed storage and memory units. The Office Action at page 7 admits that Padgett does not explicitly disclose said fingerprint file being comprised of at least one identifying characteristic of the user computer. However, the Office Action asserts that Cane discloses said fingerprint file being comprised of at least one identifying characteristic of the user. As stated above and repeated here, Applicant respectfully submit that the Examiner did not consider the claimed invention as a whole. In order for Cane to cure the deficiency of Padgett and Ross, it needs to be established that Cane teaches all claim features argued above with respect to the identification of user computer. Clearly, it is not sufficient for Cane to teach only the user computer identification, it must disclose the user computer identification using the claimed elements. The Office Action does not point to any

passage in Cane that discloses the claim features discussed above. Applicant could not find a passage in Cane that teach or suggest these claim features either.

The Office Action at page 7 alleges that Beetcher discloses the claimed invention except for a second fingerprint file. The Office Action's position assumes that the claimed invention has merely added a second fingerprint file to a well-known device. On the contrary, the claimed invention includes *the second fingerprint file, a storage unit to receive information indicative of a second fingerprint file, and a processor for performing operations based on the second fingerprint file.* As such, the claimed invention has not merely duplicated the essential working parts of a device, but has created a patentable clearing house computer.

For the combination of Padgett, Ross, Cane, and Beetcher to teach each and every elements of claim 34, Beetcher must teach what Padgett, Ross, and Beetcher are lacking. The Office Action does not point to any passage in Beetcher that disclose the claim features discussed above. Applicant could not find any passage in Beetcher that teaches or suggests the claim features either.

As such, at least for the reasons noted above, Padgett, Ross, Cane, and Beetcher, individually or in the combination fail to teach or suggest each and every element of claim 34. Therefore, Applicant respectfully submit that independent claim 34 and its dependent claims 35-39 are allowable and it is requested the claim rejections under 35 U.S.C. § 103(a) be withdrawn.

THERE IS NO SUGGESTION TO COMBINE PADGETT WITH ROSS, CANE AND BEETCHER

Padgett teaches using biometric information to authenticate electronic messages (see Padgett at column 1, lines 6-11). Ross teaches a system for authenticating human fingerprints. (see Ross at Abstract) Cane teaches to a method and system for protecting computer program distribution within a broadcast. (see Cane at Abstract) Beetcher describes techniques for restricting the ability of a computer user to use licensed software in a manner inconsistent with the license (see Beetcher at column 1, lines 7-11), whereas The Office Action has improperly combined Padgett

and Ross with Cane and Beetcher. For a proper combination, the Office Action must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. In re Fine, F.2d 107 1, 1074,5 USPW2d 1596, 1598 (Fed. Cir. 1988).

The Fine court stated:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413,425,208 USPQ 871,878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 732 F.2d at 1577,221 USPQ at 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. (emphasis in original).

The Office Action at page 7 asserts that one of ordinary skill in the art would combine Padgett with Cane "in order to increase security in systems that utilize unique hardware identifiers." However, this assertion and the other ones made with respect to combining Padgett with Ross and Beetcher are unfounded, as the Office Action does not identify a single passage in any of the references that teaches or suggests combining Padgett with Ross, cane, and Beetcher. Because there is no teaching or suggestion to combine the cited references, Applicant submits that the combination is improper. As such, Applicant requests withdrawal of the rejections under 35 U.S.C. § 103(a).

OFFICIAL NOTICE

Applicant objects to the Examiner's taking Official Notice in claims 21, 22, 25, 31, 33, and 39. Applicant respectfully requests that the Examiner provide references supporting the concepts for which Official Notice is taken.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant’s attorney 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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